

## REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the Claims in the present Application.

CLAIMS	STATUS	DEPENDENCY
1	Currently amended	Independent
2	Currently amended	1
3	Currently amended	1
4	Currently amended	1
5	Canceled	—
6	Currently amended	2
7	Withdrawn	2
8	Withdrawn	2
9	New	Independent

Comments of Primary Examiner Cassandra DAVIS have been reviewed carefully along with pertinent sections of the Patent Act, Patent Rules, the Manual of Patent Examining Procedure, legal treatises and relevant decisional law. The Application has been amended in accordance with Primary Examiner DAVIS' requirements, allowance of the Application, as amended, is solicited earnestly.

The Examiner has stated:

Claim 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office Action.

Claim 5 has been canceled and the subject matter of Claim 6 has been presented in new Claim 9 which includes the limitations of the base claim. New Claim 9 is believed to be patentable.

Claims 1-4 and 6 have been amended in accordance with the Examiner's comments. Claims 1-4 and 6, as amended, are believed to be patentable.

Claims 7-8 have been withdrawn.

Claims 1-4 and 6 have been rejected under 35 USC 103(a) as being unpatentable over *Bucknell* UK Patent Application 2 170 757 in view of *Schmaker*, DE 37 18369.

Claims 1-4 have been rejected under 35 USC 103(a) as being unpatentable over *Bucknell* in view of *Zer et al* US Patent 5,860,725.

Reconsideration of the Examiners rejection of Claims 1-4 and 6 is requested on the following basis and Examination of the *Bucknell*, *Schmaker* and *Zer et al* patents reveals the following differences between the structures shown thereon, the structure of the present invention and the statements of the Examiner.

1. *Bucknell* discloses a table decoration employing candles comprising a rotating bearer (15) with evenly distributed vanes (16) fixed to its external surface. The vanes are not ornaments.

2. As correctly noted by the Examiner, *Bucknell* does not teach the short tapered rod on the rotating bearer and the recess around the rod (12).

3. In *Schimeker's* rotating shadow luminary, the rotating bearer (1, 15) with ornamental openings (22) and the evenly distributed vanes (19) are two components.

4. In the present invention as shown and as claimed an ornament (8) is fixed to a rotating bearer (1). The external surface has the function of vanes. The observer can't see the vanes. The ornament and the vanes are combined as one component. Therefore, *Schirmeker's* device is substantially different from the present invention.

5. *Zer et al* disclose a heat operated rotatable lamp shade assembly 10 (Reference to FIGS. 1 and 2) which includes a lamp shade 12 and a plurality of vanes 14 attached to an upper portion 16 of lamp shade 12. Lamp shade 12 includes a body portion 18 preferably constructed of a high temperature resistant material, such as polycarbonate. Body portion 18 of lamp shade 12 may be transparent, translucent or opaque. Preferably a decorative design 20 is printed, silk-screened, etched or otherwise formed on body portion 18. Similar to *Bucknell*, the rotated lamp shade 12 with decorative design 20 and

the plurality of vanes 14 are two components. Therefore, *Zer et al*'s technology scheme is also quite different from the present invention.

6. *Zer et al* does not show a short taper rod.

7. *Zer et al* does not show a vertical rod fixed to a base in combination with a short taper rod.

The references do not disclose an ornament (8) fixed to rotating bearer (1) external surface having the function of vanes.

There is no teaching in the *Bucknell*, *Schirneker* and *Zer et al* and references taken alone or in combination which leads to the structure of the present invention.

For the above reasons the application of the *Bucknell*, *Schirneker* and *Zer et al* references is not considered to be appropriate.

In a famous footnote in *Hodosh v. Block Drug Co.*, 786 F2d 1136, 229 USPQ 182, 1897 (Fed. Cir., 1986), the Federal Circuit set out five principles, with citations to previous cases, regarding obviousness determinations under Section 103. The footnote (as to the first four principles) reads as follows:

Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying § 103;

(1) the claimed invention must be considered as a whole (35 USC 103); see, e.g. *Jones v. Harty*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir., 1984) (though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

(2) the references must be considered as whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 220 USPQ 481, 488 (Fed. Cir. 1984);

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g. *W.I. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));

(4) "ought to be tried" is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530,

220, USPQ at 1026).

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues herein involved.

It is submitted that the Examiner's position in applying *Bucknell*, *Schirmeker* and *Zer* et al contrary to the above-quoted tenets of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as whole, it is self-evident that Applicant's invention is not rendered obvious by the cited prior art, whether considered alone or in combination.

The statutory presumption of 35 USC § 282 makes an invention presumptively non-obvious unless the Examiner can demonstrate the "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains," 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention;; (3) the level of the ordinary skill when the invention was made; and (4) any other objective considerations including evidence of commercial success, copying, and a long-felt need in the industry. *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1270, 1273 (Fed. Cir. 1991) (citing *Graham v. Deere Co.*, 383 US 1.17 (1966)). The decision maker is not to apply hindsight, but must analyze obviousness from the viewpoint of a person skilled in

the art prior to the disclosure of the present invention *Panduit Corp. v. Dennis Mfg., Co.* 810 F2d 1561, 1566 (Fed. Cir.), *cert denied*, 481 US 1052 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely "icing on the cake". *Hybrietch, Inc. v. Monoclonal Antibodies, Inc.*, 802 F2d 12367, 1380 (Fed. Cir. 1986), *cert denied*, 4580 US 947 (1987). The Federal Circuit has stated that:

(I)ndeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant's invention from selecting bits and pieces from *Bucknell*, *Schirmeker* and *Zer* et al. The cherry picking exercise is just the sort of hindsight reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggests to a person of ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. *Panduit Corp.* 810 F2d at 1568. The prior art existed for many years and yet those skilled in the art never created heat induced rotating ornament through driving vanes comparable to Applicant's. See *Id*

at 1577 (that skilled workers did not create (patented) invention, despite existence of elements in the prior art, is evidence of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weigh strongly in favor of conclusion that Applicant' invention is not obvious. *Continental Can*, 948 F2d at 1273.

The status of the Claims is as follows:

Claim 5 has been canceled.

Claims 1-4 and 6 have been amended.

Claim 9 is new.

Claims 7-8 have been withdrawn.

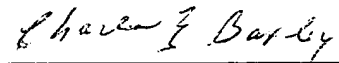
It is believed that Claims 1-4, 6 and 9 are patentable.

In view of the foregoing submissions and explanations, it is believed that Claims 1-4, 6 and 9 are in condition for allowance. An early Notice of Allowance on the Application will be appreciated.



Courtesy, cooperation and skill of Primary Examiner Cassandra DAVIS are appreciated and acknowledged.

Respectfully,



---

CHARLES E. BAXLEY  
Attorney of Record  
USPTO Reg 20,149  
90 John Street, Third Floor  
New York, NY 10038  
Tel: (212) 791-7200  
Fax: (212) 791-7276

Dated: New York, New York  
April 29, 2005